

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 13-16, 20, 23, 27, 30, 32, and 35 will have been amended, and claims 17-19, 21-22, 24-26, 28-29, 31, 33-34, and 36 will remain pending for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Turning to the merits of the action, the Examiner has rejected claims 13-15 and 20-22 under 35 U.S.C § 103(a) as being unpatentable over ISHIBASHI et al. (U.S. Patent No. 6,374,291) in view of RFC 2305. The Examiner also has rejected claims 16-19 and 23-26 under 35 U.S.C § 103(a) as being unpatentable over ISHIBASHI et al. (U.S. Patent No. 6,374,291) in view of RFC 2305 and further in view of CHEN et al. (U.S. Patent No. 5,832,208). The Examiner further rejected claims 27, 30, 32, and 35 under 35 U.S.C § 103(a) as being unpatentable over WING (U.S. Patent No. 6,650,440) in view of PAUL (WO 99/33188). The Examiner further rejected claims 28-29, 33-34, 31, and 36 under 35 U.S.C § 103(a) as being unpatentable over WING (U.S. Patent No. 6,650,440) in view of PAUL (WO 99/33188) and further in view of IWAZAKI (U.S. Patent No. 6,687,742).

Regarding the IWAZAKI patent (U.S. Patent No. 6,687,742) cited by the Examiner against claims 28, 29, 30, 34, 31 and 36 in combination with WING and PAUL,

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Applicant first notes that a copy of this document was not provided to Applicant with the last Official Action. Moreover, Applicant notes that this document was not cited on the PTO-892 Form accompanying the last Official Action. Further, Applicant notes that the Examiner has not made this document of record in any previous action in the present application nor has this document been listed on any PTO-1449 Form or PTO-892 Form in the present application.

Accordingly, Applicant respectfully requests that this document be listed on a PTO-892 Form to confirm its consideration by the Examiner and that Applicant's period for response in the present application be restarted in view of the non-citation and non-provision of a copy of this document to Applicant, as is required.

Applicant additionally notes that the IWAZAKI document issued as a patent on February 3, 2004 and was filed in the U.S. Patent and Trademark Office on May 31, 2000. Thus, its availability as a reference against any of the claims in the present application is only under 35 U.S.C. § 102(e). In this regard, Applicant notes that the present application is based upon and enjoys the effective filing date of JP 11-321411 which was filed on November 11, 1999, which is before the 35 U.S.C. § 102(e) date of the IWAZAKI reference relied upon by the Examiner. Thus, Applicant submits that the IWAZAKI reference is an inappropriate basis for the rejection of any of the claims in the present application. Nevertheless, since the IWAZAKI reference was only applied against several dependent claims in the present application, and since Applicant will provide adequate and sufficient evidence regarding the shortcomings and deficiencies of

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the references utilized together with IWAZAKI, Applicant is not at this time submitting a certified English language translation of the priority document to perfect his claim for priority based thereupon. However, Applicant is pointing out the unavailability of the disclosure of IWAZAKI against the claims in the present application and may, if appropriate, file a certified English language translation at some later time.

As noted above, Applicant has amended claims 13, 16, 20, 23, 27, 30, 32, and 35, and claims 14-15, 17-19, 21-22, 24-26, 28-29, 31, 33-34, and 36 remain pending for consideration. Applicant respectfully traverses the above rejections based on these amended claims 13, 16, 20, 23, 27, 30, 32, and 35, and will discuss the rejections with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims and do not raise new issues.

Applicant's claims 13-15 relate to an image receiving apparatus which has a receiver configured to receive an e-mail with data attached, via a computer network, and which has a controller configured to convert the attached data into image data. The controller judges whether or not the received e-mail is an error mail, based on whether or not a header of the received e-mail includes a predetermined character string. The predetermined character string is related to a sender of the error mail. Further, the error mail is related to an e-mail transmitted by the image receiving apparatus. Claims 20-22 recite related methods.

Applicant's claims 16-19 relates to an image receiving apparatus which receives an e-mail. The e-mail includes a header and a body which has a message. The message includes an image data part. The image receiving apparatus has a receiver configured to receive an e-mail with data attached, via a computer network. The image receiving apparatus also has a controller configured to convert the attached data to image data. The controller further searches for a predetermined image data fixed code in the image data part of the e-mail when the received e-mail is a multi-part structure, and judges that the received e-mail is an error mail when the predetermined image data fixed code is detected. The error mail is related to an e-mail transmitted by the image receiving apparatus. Claims 23-26 recite related methods.

Applicant's claims 27-29 relate to an image receiving apparatus connected to a server and configured to receive an e-mail, when the received e-mail is an error mail. The error mail includes a header and a body which has a message. The message includes an image data part. The image receiving apparatus has a receiver configured to receive an e-mail to which data is attached, via the server, and has a converter configured to convert the attached data into image data. The image receiving apparatus also has a memory configured to store a predetermined image data fixed code. Further, the image receiving apparatus has a controller which searches for a predetermined header fixed message in the header of the received e-mail, searches for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of the received e-mail, and judges that the

received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory. The error mail is related to an e-mail transmitted by the image receiving apparatus. Claims 32-34 recite related methods.

Applicant's claims 30-31 relate to an image receiving apparatus connected to a server and configured to receive an e-mail, when the received e-mail is an error mail. The received error mail includes a header and a body which has a message. The message includes an image data part. The image receiving apparatus has a receiver configured to receive an e-mail with data attached, via the server, and has a converter configured to convert the attached data into image data. The image receiving apparatus also has a first memory configured to store at least one predetermined character string, and has a second memory configured to store a predetermined image data fixed code. The image receiving apparatus has a controller which searches for character string in a [From:] field of the header of the received e-mail, compares the character string in the [From:] field of the header with the at least one predetermined character string stored in the first memory, searches for an image data fixed code in the image data part of the message of the body of the received e-mail when the character string in the [From:] field of a header matches the at least one predetermined character string stored in the first memory, and judges that the received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the

second memory. The error mail is related to an e-mail transmitted by the image receiving apparatus. Claims 35-36 recite related methods.

Before discussing the rejection of the claims in detail, Applicant notes that the Examiner, in the first paragraph on page 3, has apparently equated "error mail" with "unwanted mail". It is respectfully submitted that the Examiner's equivalence is incorrect. There is no relationship between mail that is merely not wanted by a receiver and error mail. Error mail, to which the present application relates, is wanted by the recipient, but has an error therein. On the other hand, the unwanted mail of ISHIBASHI et al. is not sent in error but is directed towards the recipient who wishes not to receive such mail. Accordingly, for this reason alone, all of the Examiner's rejections, which are based upon references that are unrelated to error mail are inappropriate. Applicant's invention is not directed towards security features of data transmission or anti-virus involved in data transmission but with error mail. The Examiner's references do not deal with error mail. The Examiner is not free to ignore the terms of Applicant's claims, as he has done in this application. Accordingly, it is submitted that the references applied by the Examiner are inadequate and insufficient to render any of the claims unpatentable.

Similarly, the RFC cited by the Examiner does not deal with error mail but rather with security and authentication of e-mail transmissions. This is also not the subject matter of the present invention. In summary, the Examiner has not cited a single reference that is related to error mail, as that term is utilized in the present application.

Nevertheless and in order to even more clearly distinguish the claims of the present application from the references cited by the Examiner, Applicant has, by the present Response, amended the claims to recite, inter alia, "that the error mail is "related to an e-mail transmitted by the image receiving apparatus". Clearly, in the field of authentication, security, anti-virus protection and unwanted mail, one does not apply those procedures to an e-mail previously transmitted by the apparatus which is now receiving the e-mail. For this yet additional reason, it is respectfully submitted that each of the Examiner's rejections are inappropriate and that Applicant's claims are clearly patentable over the references cited by the Examiner. An early indication to such effect is respectfully requested in due course.

Regarding claims 13-15 and 20-22, as the Examiner admitted in the outstanding Official Action mailed on May 20, 2004, ISHIBASHI et al. do not disclose a controller which is configured to judge whether or not the received e-mail is an error mail, based on whether or not a header of the e-mail includes a predetermined character string, the predetermined character string being related to a sender of the error mail. Additionally, col. 6, lines 34-44 of ISHIBASHI et al. merely point out that inputting a password can prevent another person from inappropriately using a communication terminal device. However, the present invention is not directed to preventing another person from inappropriately using the communication terminal device, but to judging whether the received e-mail is an error mail. Further, the error mail of the present invention is related to an e-mail which the image receiving apparatus itself has transmitted (see, Fig. 6

of the present invention). In other words, the present invention judges whether the received e-mail is a return of an e-mail to the image receiving apparatus, the e-mail having been transmitted by the image receiving apparatus itself. Thus, this paragraph of ISHIBASHI et al. does not disclose the features of the present invention.

Further, regarding claims 14-15 and 21-22, Fig. 11 of ISHIBASHI et al. shows a Transmission Notification Report which is printed to notify a user that an e-mail has been transmitted (see. col.7, lines 61-67, col.8, lines 1-14 of ISHIBASHI et al.). Fig. 12 of ISHIBASHI et al. shows a Reception Notification Report which is transmitted to a transmitting apparatus to notify the transmitting user of receipt of the e-mail (see. col.8, lines 58-63 of ISHIBASHI et al.). However, claims 14-15 and 21-22 do not recite the Transmission Notification Report of Fig. 11 and the Reception Notification Report of Fig. 12, since claims 14-15 and 21-22 print predetermined information of an "error mail." As explained above, ISHIBASHI et al. do not teach the claimed error mail which is related to an e-mail transmitted by the image receiving apparatus. Thus, ISHIBASHI et al. do not disclose the features of claims 13-15 and 20-22.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15 and 20-22 are not disclosed in ISHIBASHI et al. cited by the Examiner.

RFC 2305 provides a general explanation for a simple mode of facsimile using Internet mail. Particularly, sections 5.1, 5.2.1, and 5.2.2 refer to avoiding unsolicited e-mails by verifying the identity of the sender, such as by encryption-based authentication.

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However, the present invention does not exclude a unwanted e-mail, but relates to judging whether the received e-mail is an error mail, and the error mail of the present invention further relates to an e-mail which the image receiving apparatus itself has transmitted. In other words, the present invention judges whether the e-mail has been returned to the image receiving apparatus, the e-mail having been transmitted by the image receiving apparatus itself. RFC 2305 does not teach the claimed error mail which relates to an e-mail transmitted by the image receiving apparatus itself. Thus, RFC 2305 does not disclose the features of the present invention.

Further, regarding claims 14-15 and 21-22, section 2.3.2 of RFC 2305 describes Processing failure, and section 5.2.4 of RFC 2305 describes Sender accountability. However, as explained above, claims 14-15 and 21-22 print predetermined information of the error mail which relates to an e-mail transmitted by the image receiving apparatus. RFC 2305 does not teach the claimed error mail. Thus, RFC 2305 does not disclose the features of claims 13-15 and 20-22.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 13-15 and 20-22 are not disclosed in RFC 2305 cited by the Examiner. Thus, pending claims 13-15 and 20-22 are submitted to be patentable over the Examiner's proposed combination, since neither ISHIBASHI et al. nor RFC 2305 discloses the combination of features recited in Applicant's claims.

Regarding claims 16-19 and 23-26, as the Examiner admitted in the above outstanding Official Action, ISHIBASHI et al. do not disclose a controller which is

“configured to judge whether or not the received e-mail is an error mail”. Further, as the Examiner admitted in the above outstanding Official Action, the combination of ISHIBASHI et al. and RFC 2305 does not disclose “searching for a predetermined image data fixed code in the image data part of the e-mail and to judge that the received e-mail is an error mail when the predetermined image data fixed code is detected”.

Therefore, it is respectfully submitted that the features recited in Applicant’s pending claims 16-19 and 23-26 are not disclosed in the combination of ISHIBASHI et al. and RFC 2305 cited by the Examiner.

CHEN et al. relate to a software agent for detecting and removing computer viruses located in attachments to e-mail messages. However, CHEN et al. do not disclose the claimed error mail which relates to an e-mail transmitted by the image receiving apparatus itself, since viruses are not transmitted by the image receiving apparatus which receives the error mail. Thus, CHEN et al. do not disclose the features of the present invention.

Therefore, it is respectfully submitted that the features recited in Applicant’s pending claims 16-19 and 23-26 are also not disclosed in CHEN et al. cited by the Examiner. Thus, pending claims 16-19 and 23-26 are submitted to be patentable over the Examiner’s proposed combination, since none of ISHIBASHI et al. , RFC 2305, and CHEN et al. disclose the combination of features recited in Applicant's claims.

Regarding claims 27 and 32, these claims relate to, as disclosed, a combination of a process which proceeds to “NO” at ST 803 of Fig. 8 and a process which proceeds to

“YES ” at ST 913 of Fig. 9. None of ISHIBASHI et al. , RFC 2305, and CHEN et al. do disclose searching for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of the received e-mail. Further, as above explained, none of ISHIBASHI et al. , RFC 2305, and CHEN et al. do teach the claimed error mail which is related to an e-mail transmitted by the image receiving apparatus itself. Thus, none of ISHIBASHI et al. , RFC 2305, and CHEN et al. disclose the features of the present invention. Nor does any proper combination of these disclosures teach the combination of features recited in these claims.

Therefore, it is respectfully submitted that the features recited in Applicant’s pending claims 27 and 32 are not disclosed in ISHIBASHI et al., RFC 2305, and CHEN et al. cited by the Examiner. Thus, pending claims 27 and 32 are submitted to be patentable over the Examiner’s proposed combination, since none of ISHIBASHI et al., RFC 2305, and CHEN et al. in any proper combination teach or render obvious the combination of features recited in Applicant's claims.

Regarding claims 27-29 and 32-34, as the Examiner admitted in the above outstanding Official Action, WING does not disclose “a memory configured to store a predetermined image data fixed code, an image data fixed code being contained in the image data part; and a controller configured to search for a predetermined header fixed message in the header of the received e-mail, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined

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header fixed message is not in the header of the received e-mail, and to judge that the received e-mail is an error when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the memory”.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 27-29 and 32-34 are not disclosed in WING cited by the Examiner.

PAUL et al. relate to a system and method for controlling delivery of unsolicited electronic mail messages. However, the present invention does not relate to filtering of junk mail, but to judging whether a received e-mail is an error mail, and the error mail of the present invention is related to an e-mail transmitted by the image receiving apparatus itself. PAUL et al. do not disclose the claimed error mail which is related to an e-mail transmitted by the image receiving apparatus itself. Further, PAUL et al. do not teach searching for an image data fixed code in the image data part of the message of the body of the received e-mail when the predetermined header fixed message is not in the header of the received e-mail. Thus, PAUL et al. do not disclose the features of the present invention.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 27-29 and 32-34 are not disclosed in either WING or PAUL et al. cited by the Examiner. Thus, pending claims 27-29 and 32-34 are submitted to be patentable over the Examiner's proposed combination, since WING, PAUL, and any proper combination thereof do not disclose the combination of features recited in Applicant's claims.

IWAZAKI relates to a communication control method in which it is possible to transmit an image of specific conditions to the transmission destination when capability of a transmission destination is unknown. However, IWAZAKI does not teach the claimed error mail which is related to an e-mail transmitted by the image receiving apparatus itself (see, Figs. 4, 6, 9, and 11 of IWAZAKI). Thus, IWAZAKI does not disclose the features of the present invention.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 27-29 and 32-34 are not disclosed in any of WING, PAUL et al., and IWAZAKI cited by the Examiner. Thus, pending claims 27-29 and 32-34 are submitted to be patentable over the Examiner's proposed combination, since none of WING, PAUL et al., and IWAZAKI disclose the combination of features recited in Applicant's claims.

Regarding claims 30-31 and 35-36, the Examiner points out in the above outstanding Official Action that the limitations of claim 3 are similar to the limitations of claim 27, and thus the claim is rejected using the same rationale. However, claim 30 relates to the combination of a process which is disclosed to proceed to ST 805, ST 806, and "YES " at ST 807 of Fig. 8, and a process which is disclosed to proceed to "YES " at ST 913 of Fig.9. On the contrary, claim 27 relates to a combination of a process which is disclosed to proceed to "NO" at ST 803 of Fig. 8 and a process which is disclosed to proceed to "YES " at ST 913 of Fig. 9. Thus, claim 30 has different features from claim 27. None of WING, PAUL et al., and IWAZAKI teach the controller, claimed in claim 30, which is "configured to search for character string in a [From:] field of the header of

the received e-mail, to compare the character string in the [From:] field of the header with the at least one predetermined character string stored in the first memory, to search for an image data fixed code in the image data part of the message of the body of the received e-mail when the character string in the [From:] field of a header matches the at least one predetermined character string stored in the first memory, and to judge that the received e-mail is an error mail when the image data fixed code in the received e-mail matches the predetermined image data fixed code stored in the second memory”.

Further, none of WING, PAUL et al., and IWAZAKI disclose the claimed error mail which is related to an e-mail transmitted by the image receiving apparatus itself. Thus, none of WING, PAUL et al., and IWAZAKI disclose the features of the present invention.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims 30-31 and 35-36 are not disclosed in none of WING, PAUL et al., IWAZAKI or any proper combination thereof cited by the Examiner. Thus, pending claims 30-31 and 35-36 are submitted to be patentable over the Examiner's proposed combination, since any of WING, PAUL et al., and IWAZAKI disclose the combination of features recited in Applicant's claims.

In the rejection set forth by the Examiner, the Examiner asserted that "ISHIBASHI's suggested exploration of art and/or provided a reason to modify the image apparatus". It is respectfully submitted that there is no basis for the Examiner's assertion. Moreover, even though ISHIBASHI et al. might generally suggest

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"exploration", this is not the motivation required under 35 U.S.C. § 103 to support a combination rejection. At the very best, any such "exploration" is merely an invitation to practitioners to invent. It is not a motivation to combine references to result in Applicant's invention. For this additional reason, it is respectfully submitted that the claims in the present application are in condition for allowance and an action to such effect is respectfully requested in due course.

The Examiner's further, generally similar assertion regarding RFC 2305 is also submitted to be inappropriate, at least for the reasons noted above with regard to the Examiner's assertion of "exploration" regarding ISHIBASHI. Moreover, since the RFC sets forth standards, it is respectfully submitted that such a document would not contain a motivation to modify the standards. Standards must be fixed and constant and cannot be randomly modified such as proposed by the Examiner. Accordingly, there is also no proper motivation for the various combinations set forth by the Examiner.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

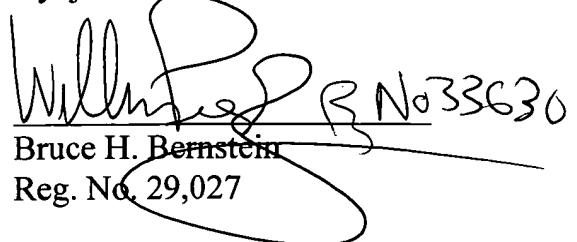
SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for consideration by the Examiner. Applicant has pointed out the impropriety of the rejections as well as the inadequacy of the references relied upon. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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